

**Serial No. 09/529,564**  
**Art Unit: 1713**

### Remarks

Claims 1-21 are currently pending in the above-captioned matter. By this amendment, claims 1, 2, 5, 6, 7, and 21 have been amended. Claims 2 and 5 have been amended to correct clerical errors. After entry of this amendment claims 1-21 are pending, claims 1, 6 and 21 being independent. Support for the amendments is found in the originally filed claims and Examples and in the original specification at page 2, lines 29-33, page 5, lines 29-33, page 12, lines 10-17, and page 13, lines 24-29. Remarks made herein are based on the claims as amended hereby.

### 35 USC §112 Rejection

Claims 1-21 were rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention in regard to the text: "a concentration of a component consisting of dissolved, dispersed, or both dissolved and dispersed materials" found in claims 1 and 21. Applicants have amended claims 1 and 21 to clarify these claims. Independent claim 6 and its dependent claims do not contain the language upon which the rejection was based. Applicants respectfully request that the rejection under 35 USC §112, second paragraph be withdrawn.

### 35 USC §103(a) Rejection

Claims 1-21 were rejected under 35 USC §103 as obvious over U.S. Patent No. 5,298,289 to Lindert et al. (the '289 patent) in view of U.S. Patent No. 5,378,291 to Ara et al. (the '291 patent). Claims 1, 6, 7, and 21 as amended are neither taught nor suggested by the combination of the '289 patent and the '291 patent.

Independent claim 1 recites a volume of a component comprising a cationic dispersing agent and a stable dispersed solid material. Both the '289 patent and the '291 patent require the use of nonionic or anionic materials. There is no teaching or suggestion in these patents that a cationic dispersing agent would be suitable. The '291 patent teaches against cationic dispersing agents.

Likewise, there is no teaching or suggestion of a composition for the process according to independent claim 6, which requires a mass of film forming molecules which are not part of substances (A) through (C) that has a selected glass transition temperature not more than 75 °C

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and present in a ratio to the stoichiometric equivalent mass as  $H_3PO_4$  from about 0.3:1.0 to about 15:1.0. There is no teaching or suggestion in the '289 patent or the '291 patent of these features or of the desirability of selecting the features recited in claim 6.

Finally, independent claim 21 recites a process using an aqueous liquid composition wherein the ratio of component (C) to component (A) is from about 0.02:1.0 to about 1.0:1.0. The ratio of "Polymer Materials" to  $H_3PO_4$  in the teachings of the '289 patent is different from claim 21. There is no teaching or suggestion that a different ratio would be desirable or would produce the surprisingly improved salt spray resistance results shown in Table 2 for compositions having the ratio recited in independent claim 21.

The combination of the references cited fails to teach or suggest Applicants' invention which is directed to coating a metal substrate with a dried in place passivating rinse. There is no teaching in the '289 patent of how to achieve Applicants invention as currently claimed, nor any motivation to change the '289 patent according to the '291 patent to achieve the invention as currently claimed.

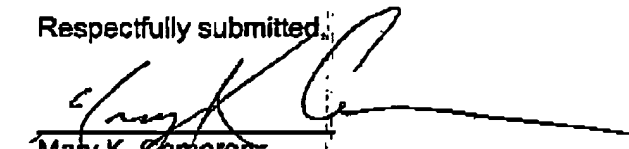
As the Office is aware, in order to support a rejection under 35 U.S.C. §103, the Office must establish that there is some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). That is, although the Office may suggest that the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. In *re Laskowski* 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989).

Applicant submits that the claims, as amended, are not prima facie obvious over the prior art of record. Furthermore, the surprising results compared to known passivates under similar test circumstances show that the rejection under 35 USC § should be withdrawn.

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Applicant requests reconsideration in view of the amendments and remarks contained herein, a copy of the claims showing the amendments made is attached hereto as an appendix. Applicant submits that the claims are in condition for allowance and a notice to that effect is respectfully requested. Should the Examiner have any questions regarding this paper, please contact the undersigned.

Respectfully submitted,

  
Mary K. Cameron  
(Reg. No. 34,789)  
Attorney for Applicants  
248 589 4672

Henkel Corporation  
Patent Department  
The Triad, Suite 200  
2200 Renaissance Boulevard, Suite 200  
Gulph Mills, PA 19406

MKC/mlc